

ESTTA Tracking number: **ESTTA704997**

Filing date: **10/28/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91206921
Party	Plaintiff Rich Products Corporation
Correspondence Address	BRIAN E TURUNG FAY SHARPE LLP 1228 EUCLID AVE 5TH FLOOR, THE HALLE BLDG CLEVELAND, OH 44115 UNITED STATES bturung@faysharpe.com, skoenig@faysharpe.com, chutter@faysharpe.com
Submission	Other Motions/Papers
Filer's Name	Diane Jacquinot on behalf of Jude A. Fry
Filer's e-mail	djacquino@faysharpe.com, jfry@faysharpe.com, skoenig@faysharpe.com, bturung@faysharpe.com, dlightbody@faysharpe.com, chutter@faysharpe.com
Signature	/dmj/
Date	10/28/2015
Attachments	PUBLIC Opposer_s Reply to Applicant_s Supplemental ACR Brief.pdf(41145 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/577,551
For the Mark: BETTER ON TOP!

Rich Products Corporation,)	
)	
Opposer,)	Opposition No. 91206921
)	
v.)	
)	
VegiPro Brands, LLC DBA Exposure SMI,)	
)	
Applicant.)	
)	
_____)	

**OPPOSER RICH PRODUCTS CORPORATION’S REPLY TO APPLICANT VEGIPRO
BRANDS, LLC’S SUPPLEMENTAL ACR TRIAL BRIEF**

Opposer, Rich Products Corporation (“RPC” or “Opposer”), submits its Reply to the ACR trial brief filed by Applicant VegiPro Brands, LLC DBA Exposure SMI (“VegiPro” or “Applicant”). RPC’s Reply is authorized by the Parties’ stipulation to proceed under the Board’s ACR procedure. *See* Doc. No. 27, ¶ 2.

REDACTED

REDACTED

Against that backdrop, a newcomer seeks to register a mark that completely encompasses RPC's registered standard character ON TOP mark for an identical product.¹ Indeed, Applicant's proposed mark differs only in that it includes a laudatory term—BETTER—in front of ON TOP followed by an exclamation point at the end. As such, a consumer would mistakenly believe Applicant's mark—BETTER ON TOP!—to be a new and improved member of RPC's ON TOP product line.

VegiPro cannot and does not dispute the evidence of record going to the longstanding, widespread use by RPC of its ON TOP Marks. Instead, VegiPro relies on a smattering of third party registrations—none of which includes the entirety of the ON TOP mark—to somehow justify its attempt to usurp RPC's well-known ON TOP mark.

Unbelievably, it is VegiPro's position here that any party can rightfully misappropriate another's registered trademark for an identical product simply by sandwiching the trademark between a laudatory term like "better" and an exclamation point. See Dkt. No. 30 at p. 1 ("Applicant's addition of the word BETTER at the beginning of its mark and an exclamation point at the end is more than enough [sic] prevent any likelihood of confusion. . ."). Surely, the law does not allow for such a blatant usurpation of another's trademark rights. Moreover, RPC's evidence of record—which unquestionably establishes the similarity of the parties' marks and the strength of the ON TOP Marks—necessitates judgment in RPC's favor in this Opposition.

¹ The mark in RPC's U.S. Reg. No. 1,882,377 is ON TOP in standard character form.

II. VEGIPRO'S RELIANCE ON *JUICE GENERATION* AND *JACK WOLFSKIN* IS MISPLACED

A. VegiPro's Evidence of Record Does Not Show That Third Parties Have Registered Variations of the "ON TOP" Marks

VegiPro does not dispute the evidence RPC has made of record showing the strength of its ON TOP Marks. Instead, VegiPro argues that the crowded field of "TOP" marks for whipped topping obviates a likelihood of confusion. Dkt. No. 30 at p. 3. VegiPro's argument relies on recent Federal Circuit decisions in *Juice Generation, Inc. v. GS Enterprises, LLC*, 794 F.3d 1334 (Fed. Cir. 2015) and *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millenium Sports, SLU*, 797 F.3d 1363 (Fed. Cir. 2015). Neither of these decisions supports VegiPro's position here.

In *Juice Generation*, the applicant was attempting to register the mark PEACE LOVE AND JUICE *and Design* for juice bar services. The opposer, GS, owned a number of registrations incorporating the phrase "PEACE & LOVE" for restaurant services. The Federal Circuit first found that the Board had erred by not considering the design element of the PEACE LOVE AND JUICE and Design mark as the dominant feature of the applied-for mark. Here, in contrast to *Juice Generation*, VegiPro is attempting to register a standard character mark for BETTER ON TOP! for *identical* goods. Accordingly, VegiPro's application is broad enough to cover RPC's design associated with its ON TOP Marks. *See, e.g.*, U.S. Reg. No. 4,215,194 for ON TOP w/Design.

The Federal Circuit also found that the Board had erred in *Juice Generation* by failing to give appropriate weight to evidence of third party registrations "containing 'peace' and 'love' followed by a third product-identifying term"—e.g., "PEACE LOVE AND PIZZA" or "PEACE

LOVE YOGURT.” *Juice Generation*, 794 F.3d at 1341, n. 1.² The Federal Circuit noted that the evidence of third party usage bears on the strength of a mark. *Id.* at 1338.

In *Jack Wolfskin*, the applicant was attempting to register a design mark for an angled paw print for use with clothing, footwear, and accessory products. *Jack Wolfskin*, 797 F.3d at 1368. The opposer’s registration consisted of the mark KELME and a paw print for use with clothing. *Id.* The Federal Circuit found that Jack Wolfskin had “presented voluminous evidence of paw print design elements that have been registered and used in connection with clothing.” *Id.* at 1373. Accordingly, the Federal Circuit found that—based on evidence of third party usage and registration—the paw print portion of the opposer’s mark was relatively weak. *Id.* at 1374. Moreover, the Federal Circuit found KELME to be the dominant portion of opposer’s mark in assessing the similarity of the marks.³ *Id.*

In stark contrast to *Juice Generation* and *Jack Wolfskin*, VegiPro’s third party registrations consist only of eight third party registrations including the words “top” or “tops” used in a manner to create a visual and phonetic impression different from the ON TOP mark. None of these registrations includes the combination of “on” and “top” or “on top.” Only two of the registrations include the word “top” as a separate component of the registration, while four of the registrations are unitary marks including the word “top” in conjunction with other word elements to create a coined term. The final two registrations are for “TOPS,” standing alone.

² The Federal Circuit found the consideration of these third party registrations to be particularly important in view of statements GS had made to the USPTO when it applied for registration of its marks to overcome the mark “PEACE LUV CHICKEN.” *Juice Generation*, 794 F.3d at 1340.

³ VegiPro’s assertion that “in *Jack Wolfskin*, Federal Circuit found the crowded field determinative of the likelihood of confusion inquiry” is not true. *See* Dkt. No. 30 at p. 6. Rather, the fact that the opposer’s mark included the word KELME (considered to be the dominant portion of the mark) was also key to that decision. *Jack Wolfskin*, 797 F.3d at 1374.

REDACTED

VegiPro's evidence of third party registrations including "top" or "tops" does not rebut RPC's extensive evidence of record showing the strength of its ON TOP Marks. Accordingly, the ON TOP Marks must be given a wide scope of protection that obviously should be broad enough to prohibit another party from promoting an identical product as a better version of RPC's ON TOP whipped toppings. *See Kenner Parker Toys v. Rose Art Indus., Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992) ("no excuse for even approaching the well-known trademark of a competitor . . . all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer . . .") (quoting *Nina Ricci, S.A.R.L. v. E.T.F. Enters.*, 889 F.2d 1070, 1074 (Fed. Cir. 1989)).

B. VegiPro's Flagrant Attempt to Adopt the Entire "ON TOP" Mark by Adding Subordinate Matter Thereto Creates a Likelihood of Confusion

The law is well-settled that confusion is likely when a newcomer adopts the entirety of a registered trademark while adding a descriptive term to avoid confusion. *See, e.g., Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design for men's cologne, hair spray, conditioner and shampoo likely to cause confusion with CONCEPT for cold permanent wave lotion and neutralizer); *Coca-Cola Bottling Co. of Memphis, Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (BENGAL LANCER similar to BENGAL); *In re Toshiba Med.*

Sys. Corp., 91 USPQ2d 1266, 1271 (TTAB 2009) (VANTAGE TITAN confusingly similar to TITAN for medical diagnostic apparatus); *Henry Siegel Co. v. M&R International Mfg.*, 4 USPQ2d 1154 (TTAB 1987) (CHIC confusingly similar to LA CHIC when both for women's clothing; customers seeing the junior user's mark could mistakenly think that it designated a particular line of clothing made by the senior user); *In re Riddle*, 225 USPQ 630, 632 (TTAB 1985) (RICHARD PETTY'S ACCU TUNE for automotive service centers confusingly similar to ACCU-TUNE for automotive testing equipment); *La Maur, Inc. v. Matney*, 167 USPQ 559 (TTAB 1970) (applicant's "ITALIAN STYLE" mark similar to registered "STYLE" mark).

Likewise, Judge Hatfield of the C.C.P.A. long ago recognized that a newcomer should not be able to avoid a likelihood of confusion by adding a descriptive term to another party's registered trademark:

If all that a newcomer in the field need do in order to avoid the charge of confusing similarity is to select a word descriptive of his goods and combine it with a word which is the dominant feature of a registered trade-mark so that the borrowed word becomes the dominant feature of his mark, the registered trade-mark, made valuable and outstanding by extensive advertising and use, soon becomes of little value, and, of course, each of the subsequent imitating trade-marks (and there would be many) is of value only to the extent that its users are trading on the good will of the owner of the original registered trade-mark.

Bon Ami Co. v. McKesson & Robbins, Inc., 93 F.2d 915, 916-917 (C.C.P.A. 1938)

The situation is even more flagrant here in that the subordinate matter tacked on to RPC's ON TOP mark gives the impression of a new and improved version of the ON TOP whipped topping. For example, the record here shows that consumers are accustomed to seeing known marks promoted in connection with laudatory terms to connote a better or improved version of that product. *See* Jacquinot Decl. at ¶¶ 3, 4; Exs. B, C. That evidence is undisputed by VegiPro.

Likewise, the evidence further shows that food products are being re-formulated to remove GMOs and being promoted as such. *See* Jacquinot Decl. at ¶ 5; Ex. D. VegiPro’s trial brief does not address that evidence. However, taking VegiPro at its word regarding the nature of its whipped topping as a vegetarian product without GMOs—consumers would view Applicant’s product as a new version of RPC’s ON TOP for the vegetarian, health-conscious consumer. Confusion would be likely.

Rather than rebut RPC’s evidence regarding how a consumer would perceive BETTER ON TOP!, VegiPro claims that its mark creates a “double entendre on words and a sexual innuendo that slyly references a sexual position in which the female partner is on top of the male partner.” Dkt. No. 30 at 8. VegiPro has no evidence supporting this assertion. However, even if this connotation is plausible, consumers would understand the double entendre to be associated with RPC’s ON TOP whipped topping and would be led to believe that RPC is promoting a reformulated ON TOP whipped topping using a tawdry sex joke. This is not the image RPC wishes to project to the marketplace. RPC is a family-owned business and the ON TOP Marks have historical significance to RPC as one of its leading brands. *See* Malchoff Decl. at ¶ 14; Ex. G. This particular connotation would disparage and cheapen RPC’s ON TOP Marks to the detriment of RPC.

Lastly, VegiPro’s argument that RPC’s packaging includes a reference to the RICH’S mark, which further distinguishes the marks (*see* Dkt. No. 30 at p. 7) is entitled to no weight whatsoever, since it is irrelevant. Two of the cited registrations do not include any reference to the RICH’S house mark. *See, e.g.*, U.S. Reg. Nos. 1,882,337 and 4,215,194 for ON TOP and ON TOP w/Design.

III. THE BOARD SHOULD PRESUME THAT THE CHANNELS OF TRADE AND CLASSES OF PURCHASER FOR VEGIPRO'S IDENTICAL PRODUCT ARE THE SAME AS THOSE OF RPC

Because there are no limitations as to channels of trade or classes of purchasers in the description of goods in the cited registration, the Board presumes that RCP's goods move in all channels of trade normal for such goods and are available to all potential classes of ordinary consumers. *See Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Moreover, because the whipped topping described in the application and the cited registrations are legally identical, the Board must presume that the channels of trade and classes of purchasers are the same. *See American Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011); *see also In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

VegiPro continues to ignore this law in its trial brief, claiming that these factors are somehow relevant notwithstanding the fact that VegiPro has yet to use this mark in commerce. Accordingly, VegiPro can only speculate as to the specific nature of its whipped topping and its channel of trades and consumers. But the application and relied-on registrations unequivocally show that the goods are legally identical and neither VegiPro's trade channels nor RPC's trade channels are so limited.

Moreover, even if this evidence was considered, VegiPro misstates the nature of RPC's evidence as it relates to its consumers and trade channels. For example, VegiPro claims that "the evidence shows that Opposer sells its product directly to the food industry only." Dkt. No. 30 at

p. 7. However, this statement is not true as the evidence shows that RPC's trade channels include cash and carry stores and grocery stores. *See* Malchoff Decl. at ¶ 9; Ex. B.

In addition, VegiPro claims that both parties' goods are sold to sophisticated purchasers. Dkt. No. 30 at pp. 9, 10. Again, not a true statement since the record shows that each parties' goods could be sold at cash and carry stores to purchasers who are off-the-street, typical grocery store shoppers. *See Id.* There is no evidence that these consumers are necessarily sophisticated.

Finally, VegiPro claims that RPC's long history of use and significant product sales do not prove that the ON TOP Marks are famous. Dkt. No. 30 at p. 10. As an initial matter, RPC's evidence included much more than just use and sales. *See* Malchoff Decl. at ¶¶ 4-14, Exs. A-G. In addition, even if RPC's evidence does not rise to the level of proving fame, it certainly proves that the ON TOP Marks are strong and should be afforded a broad scope of protection. *See, e.g., Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q. 2d 1164, 1170 (T.T.A.B. 2011) ("[F]ame for likelihood of confusion purposes and fame for dilution purposes are not necessarily the same. A mark may have acquired sufficient public recognition and renown to demonstrate that it is a strong mark for likelihood of confusion purposes without meeting the stringent requirements to establish that it is a famous mark for dilution purposes."); *Kenner Parker Toys*, 963 F.2d at 353 (A strong mark . . . casts a long shadow which competitors must avoid.").

IV. CONCLUSION

For the foregoing reasons, RPC respectfully requests that the Board sustain the Opposition and refuse registration of U.S. Serial No. 85/577,551.

Dated: October 28, 2015

Respectfully submitted,

FAY SHARPE LLP

/s/ Jude A. Fry
Brian E. Turung
Sandra M. Koenig
Jude A. Fry
The Halle Building, 5th Floor
1228 Euclid Avenue
Cleveland, Ohio 44115
Phone: (216) 363-9000
Fax: (216) 363-9001
E-mail: bturung@faysharpe.com
 skoenig@faysharpe.com
 jfry@faysharpe.com

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on October 28, 2015, the foregoing **OPPOSER RICH PRODUCTS CORPORATION'S REPLY TO APPLICANT VEGIPRO BRANDS, LLC'S SUPPLEMENTAL ACR TRIAL BRIEF** was filed electronically. Notice of this filing was served by electronic mail on the following attorney for Applicant:

Bruno W. Tarabichi
btarabichi@owenstarabichi.com
Owens Tarabichi LLP
111 N. Market St., Suite 730
San Jose, CA 95113

/s/ Jude A. Fry
Jude A. Fry
Attorney for Opposer

RICH 701110US01 1563570 1